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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,342	03/29/2000	Hironori Morito		6601

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EXAMINER
LEE, TOMMY D

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 May 2005 and 20 June 2005</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June

20, 2005 has been entered.

Claim Rejections - 35 USC § 103

2.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

3.   Claims 1, 2 and 9-26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent 5,103,490 (McMillin) in view of U.S. Patent 6,370,280 (Cok et al.) and

U.S. Patent 6,209,004 (Taylor).

Regarding claims 1, 2 and 9, McMillin discloses a data converting apparatus

comprising: a data converting part converting a set of image data that can be processed

by an image forming apparatus forming an image on a medium in accordance with the

set of image data (column 5, lines 24-41; column 6, lines 25-37); and a superimposing

part superimposing at least a first set of image data converted from a first set of input

data substantially prior to a time of printing (unmarked master stored (column 6, lines

25-29); retrieved prior to printing (column 6, lines 59-63)) and a second set of image

data converted from a second set of input data different from the first set of input data,

the second set of input data including non-image data (response-marked form, including

non-image data such as characters (Fig. 2b) also retrieved from storage (column 6,

lines 59-63), to generate a single set of superimposed image data (column 6, lines 63-

67)), wherein the image forming apparatus forms an image on the medium based on the

single set of superimposed image data (column 6, lines 38-56), and wherein the

superimposing part superimposes the first and second sets of image data substantially

when the image forming apparatus receives a command to form the image on the

medium (superimposing responsive to retrieval request (Fig. 4)). The data converting

apparatus further comprises a data sending part sending the single set of superimposed

image data to the image forming apparatus (column 6, lines 57-67); and a previewing

part previewing the single set of superimposed image data generated by the

superimposing part (column 6, lines 63-68).

McMillin does not disclose a limiting part limiting use of the single set of

superimposed image data in accordance with limitation information showing a limitation

of use of the single set of superimposed image data, wherein the limitation information

includes a first permission of a user to initiate the superimposing by the superimposing

part. Cok et al. disclose a system for producing composite images, wherein production

of composite images may be permitted or inhibited on the basis of customer

identification (column 3, lines 36-48; column 4, lines 21-48). By requiring such limiting

information, unauthorized use may be prevented (column 4, lines 43-48), thereby

enhancing the security of the system. Therefore, it would have been obvious for one of

ordinary skill in the art to modify the teaching of McMillin by providing a limiting part

such as disclosed in Cok et al.

The limitation information disclosed in Cok et al. does not include a second

permission of a user to modify the single set of superimposed image data, or a third

permission of a user to delete the single set of superimposed image data. Taylor

discloses a method and system for generating and distributing document sets, wherein

a user may be assigned a unique password that gives the user access to a specific

level of permission for review, editing or deletion of a document (column 4, lines 17-20).

While the document is not specifically composed of superimposed image data, one of

ordinary skill in the art would have recognized that the teaching in Taylor, when applied

to Cok et al., would provide a greater level of security by further limiting the ability of

unauthorized users to modify or delete image data, regardless of the type of image

data, stored in the system. Therefore, it would have been obvious for one of ordinary

skill in the art to modify the combined teaching of McMillin and Cok et al., by providing

second and third permissions as disclosed in Taylor.

Claims 11, 12 and 17 are method claims corresponding to above-rejected

apparatus claims 1, 2 and 9, respectively. The steps corresponding to the limitations

recited in the apparatus claims are disclosed in McMillin, as set forth above.

Regarding claims 13-16, McMillin further discloses steps of superimposing at

least one set of image data over another set of image data that is converted from the

set of input data and stored as a predetermined form (column 5, lines 24-30); selecting

a desired form from at least one predetermined form and superimposing at least one set

of image data over the desired form (column 7, lines 18-21); enabling changing of the predetermined form by changing of layout information that indicates a position where the predetermined form is formed on the medium and is stored by associating with the predetermined form (column 10, lines 3-42).

Claims 19-25 recite the steps of above-rejected method claims 11-17, respectively, as a program recorded on a computer-readable medium. Storage of a program for performing image processing steps in general, while not taught by McMillin, is well known in the art, and it would have been obvious for one of ordinary skill in the art to provide a program for performing the steps taught by McMillin so that such step may be performed by a computer, without requiring specific image processing hardware for performing each of the steps.

Regarding claim 10, McMillin discloses a data converting apparatus comprising: a data converting part converting a set of input data into a set of image data that can be processed by an image forming apparatus forming an image on a medium in accordance with the set of image data (column 5, lines 24-41; column 6, lines 25-37); a superimposing part superimposing at least two sets of image data converted from at least two different sets of input data to generate a single set of superimposed image data, wherein the image forming apparatus forms an image on the medium based on the single set of superimposed image data (column 6, lines 38-56); and a form storing part selectively storing the set of image data converted from the set of input data as a predetermined form that is superimposed (column 5, lines 24-30).

McMillin does not disclose a limiting part limiting use of the predetermined form in accordance with limitation information that the form storing part stores associated with the predetermined form, wherein the limitation information includes a first permission of a user to initiate superimposing by the superimposing part. Cok et al. disclose a system for producing composite images, wherein production of composite images may be permitted or inhibited on the basis of customer identification (column 3, lines 36-48; column 4, lines 21-48). By requiring such limiting information, unauthorized use may be prevented (column 4, lines 43-48), thereby enhancing the security of the system. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of McMillin by providing a limiting part such as disclosed in Cok et al.

The limitation information disclosed in Cok et al. does not include a second permission of a user to modify the superimposed predetermined form, or a third permission of a user to delete the superimposed predetermined form. As mentioned above, Taylor discloses a method and system for generating and distributing document sets, wherein a user may be assigned a unique password that gives the user access to a specific level of permission for review, editing or deletion of a document (column 4, lines 17-20). While the document is not specifically composed of a superimposed predetermined form, one of ordinary skill in the art would have recognized that the teaching in Taylor, when applied to Cok et al., would provide a greater level of security by further limiting the ability of unauthorized users to modify or delete image data, regardless of the type of image data, stored in the system. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of

McMillin and Cok et al., by providing second and third permissions as disclosed in

Taylor.

Claim 18 is a method claim corresponding to above-rejected apparatus claim 10.

The steps corresponding to the limitations recited in the apparatus claim is disclosed in

the combined teaching of McMillin and Cok et al., as set forth above.

Claim 26 recites the steps of above-rejected method claim 18 as a program

recorded on a computer-readable medium. Storage of a program for performing image

processing step in general, while not taught by McMillin, is well known in the art, and it

would have been obvious for one of ordinary skill in the art to provide a program for

performing the steps taught by McMillin so that such steps may be performed by a

computer, without requiring specific image processing hardware for performing each of

the steps.

4.   Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McMillin in view of Cok et al. and Taylor as applied to claim 1 above, and further in view

of U.S. Patent 6,594,405 (Flannery).

The combined teaching of McMillin, Cok et al. and Taylor does not suggest

storing limitation information by associating with a predetermined form, as recited in

claim 3. Flannery, as set forth on page 3 of the Office action mailed May 17, 2004,

discloses a method and apparatus for combining foreground and background

information on a preprinted form (read Abstract), wherein limitation information is used

and stored in association with a predetermined form (parameters limiting paper size,

number of pages in a form, may be stored for later retrieval (column 4, lines 20-28)). By

providing such information, a user can provide a composite image in a suitable manner in accordance with specific requirements regarding a size or number of pages, and thus it would have been obvious for one of ordinary skill in the art to provide a means or step of providing and storing limitation information, such as disclosed by Flannery, in the combined teaching of McMillin, Cok et al. and Taylor.

Apart from the above-mentioned storage of limitation information, claims 3, 5, 6 are method claims corresponding to above-rejected apparatus claims 13-15, respectively. The limitations corresponding to the steps recited in the method claims are disclosed in McMillin, as set forth above.

Regarding claims 4 and 7, the form storing part of McMillin further comprises a registration part registering the set of image data as a predetermined form that is superimposed (column 5, lines 24-30); and a store control part selectively storing the predetermined form changed by the form changing part (column 10, lines 3-42). Further regarding claim 8, the form changing part changes layout information of the predetermined form on the medium, which information the form storing part stores by associating with the predetermined form, as mentioned above with respect to claim 16.

Response to Arguments

5.   Applicant's arguments, see REJECTION UNDER 35 U.S.C. §112 on page 8 of applicant's amendment, filed May 24, 2005, with respect to claims 3-8 have been fully considered and are persuasive. The rejection of these claims under 35 U.S.C. §112 has been withdrawn.

6.   Applicant's arguments filed in response to rejections under 35 U.S.C. §102 and

35 U.S.C. §103, as set forth on pages 9-11 of the applicant's amendment have been

fully considered but they are not persuasive.

Applicant's arguments are based on the claims as amended. The newly added

limitations (second and third permissions of a user to modify and delete, respectively,

superimposed image data or a superimposed predetermined form) are suggested by

the combined teaching of Cok et al. and Taylor, as mentioned in the above rejection of

the claims.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-

7436. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate

Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number

for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
July 18, 2005